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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,724	10/23/2003	Lawrence R. Miller	388022003700	2387

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,724

Applicant(s)

MILLER ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended claim 1. Pending claim 1 was examined in this final Office Action. The Examiner is suggesting to the Applicant to consider a telephone interview for further discussion.

Response to Arguments

Applicant's arguments filed 26 January 2006 have been fully considered but they are not persuasive. The instant application defines a buyer as being the subscribing customer and the seller being a relying customer. Asay was referenced in its entirety by Frankel, both patents being assigned to CertCo, and are consistent with regards to terminology. Frankel discloses a buyer as client 1 and the seller as client 2. Asay teaches a vendor as a relying party.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 1 is rejected under 35 USC 103(a) as being unpatentable over Frankel et al. (US 6,353,812 hereinafter referred to as “Frankel”) in view of Asay (Paper #2, US 5,903,882 hereinafter referred to as “Asay”).**

Frankel teaches a system and method for providing warranties that warrant one or more facts associated with a digitally signed electronic message using a four-corner model (see at least abstract; Fig. 1 (Client 1, Local Rep for Client 1, Client 2, Local Rep for Client 2); col. 3, lines 50 through col. 4, line 51). Frankel teaches a Warantee and a Warranty Subject (please note: both are clients that can either be a warrantee or warranty subject) (see at least col. 10, line 41-57). Frankel further teaches:

- Requesting a warranted amount by the subscriber; claim period:
requesting party requests warranty amount; time period established;
requester is a buyer (subscriber as defined by Applicant) (see at least col. 4, line 52 through col. 6, line 30; col. 10, line 41 through col. 11, line 48).
- Transmitting a message that confirms issuance of the requested warranty; message digitally signed; warranty comprising contract between the entity and subscriber; confirming issuance of the requested warranty (see at least Fig. 4 (8 and 9); col. 9, lines 53-56).

Frankel teaches all the above as noted under the 103(a) rejection and teaches a) the four-corner model providing a warranty-granting system, b) either client being able to request a warranty and relying on the warranty to reduce risk in a transaction, and c) the requesting client's local trusted representative issuing

warranties, but does not disclose risk management issues associated with local trusted representative. Asay teaches a method of managing risk in an electronic transaction system using a four-corner model (see at least abstract; Fig. 1 (100); Fig. 6 (200); col. 4, line 20 through col. 9, line 45). Asay further teaches:

- Assigning a warranty cap to an entity that issues digital certificates:
Certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: "some value" is a cap that was previously assigned a value) (see at least col. 33, lines 29-31).
- Tracking a warranty volume for the entity:
Reliance manager tracks the cumulative liability of each certification authority (see at least Fig. 6 (206, 218, 220); col. 33, lines 20-21).
- Evaluating the request for a warranty; not to exceed cap: evaluates risk, bounds risk, thresholds (see at least col. 4, lines 43-48); certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: evaluation is based on cap being exceeded which triggers notification) (see at least col. 33, lines 29-31).
- Transmitting a message that confirms issuance of the requested warranty; message digitally signed; warranty comprising contract between the entity and subscriber; relying party being a third-party beneficiary: confirming issuance of the requested warranty (see at least col. 42, lines 27-57);

most legal systems treat a certificate as a representation pursuant to a contract between the issuing certificate authority and the subscriber; persons other than the subscriber may rely on the certificate (e.g. relying party); treating the relying party as a third-party beneficiary of the contract between the subscriber and certificate authority (see at least col. 2, lines 21-33); messages are digitally signed (see at least col. 1, lines ; col. 32, lines 27-37; col. 34, lines 33-51; col. 41, lines 10-41).

- Receiving a validation request from the relying party: relying party sends a validation request (see at least Fig. 6 (212, 216); col. 32, lines 29-32; col. 41, lines 42-57).
- Transmitting a validation response to the relying party: sends validation to relying party (see at least Fig. 6 (212, 226); col. 44, line 62 through col. 45, line 43; col. 46, lines 4-).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Frankel to implement risk management methods as taught by Asay, in order to manage the risk of issuing entities, and thereby attract participants to the service.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name.

Robert M. Pond
Primary Examiner
April 11, 2006